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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,388	02/20/2002	John A. Roderick	05211-018001	1612

26161 7590 05/07/2003

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

CAMPBELL, KELLY E

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/081,388	Applicant(s) RODERICK, JOHN A.
	Examiner Kelly E Campbell	Art Unit 3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
 - 2a) This action is FINAL. 2b) This action is non-final.
 - 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- Disposition of Claims**
- 4) Claim(s) 1-66 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 - 5) Claim(s) _____ is/are allowed.
 - 6) Claim(s) 1-66 is/are rejected.
 - 7) Claim(s) _____ is/are objected to.
 - 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2,6-9,11,22-24,27,57, 61-66 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Capria (US 5,249,376).

a shoe defining a normal walking direction and including:

a sole (16) defining a forward region, see Figure 1, positioned beneath toes and at least part of a ball of a foot (not shown), see Column 2, lines 32-34, received within the shoe and having a lower surface exposed across the forward region to engage a supporting surface for walking thereon;

and at lease one roller (20) secured to the sole (16) and disposed rearward of the forward region, see Figure 1, the roller (20) mounted to rotate about an axle (18) defining a primary axis of rotation extending at an angle of between about zero and 45 degrees to the walking direction as viewed from above the shoe (16), see Figure 3, and able to roll sideways along a support surface, see Column 1, lines 50-56;

wherein the roller (20) is removable, see Column 2, lines 38-42;

wherein the axle (18) is mountable to the sole (16) in a plurality of selectable orientations, see Figure 3;

wherein in one of the axis orientations the axle defines an alternate axis of rotation extending substantially perpendicular to the walking direction, see figure 3;

wherein the shoe (16) can comprise two or more rollers (20) laterally spaced apart across the sole (16) or spaced apart along the walking direction, see figure 3;

wherein the sole (16) defines a cavity (14) having an opening at the lower surface of the sole (16) defined by front and rear plates (10,12) the roller (20) partially disposed within the cavity;

wherein the roller (20) is an elongated, cylindrical, barrel-shaped wheel, see Figure 3.

With regards to claims 61-66, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. Ex parte Pfeiffer, 1962 C.D. 408 (1961).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capria (US 5,249,376).

With regards to claims 10 and 12 it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the spacing between elements to be a specific ratio, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 3-5,16-17,25-26,35,37-39,40-51,58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capria (US 5,249,376) as applied to claim 1, and further in view of Adams (US 6,450,509).

Capria teaches all aspects of the claimed invention including a single axle capable of carrying multiple rollers, as discussed above for claim 1, except a retractable rolling mechanism, flexible sole and grinding plate.

Adams teaches a shoe (10) having a sole (14) and a rolling apparatus consists of two rollers (42a,42b)

wherein the sole (14) is flexible for bending during walking, see Claim 2, for improved comfort when walking;

wherein the rolling apparatus (42a,42b) would form a lowermost portion of the shoe (10), see Figure 7, and the two rollers (42a,42b) have a lateral spacing and and further including a grinding surface (44), see Figure 3a, disposed in the mid-sole area of the sole (14), see Figure 3a, and forming a laterally extending channel for receiving a rail;

wherein the sole (14) defines a cavity (40a,40b) at the lower surface of the sole (14), the rollers (42a,42b) being partially disposed within the cavity (40,40b) and extending through the cavity opening (40a,40b), see Figures 3b and figure 7;

referring to Figure 5, the roller (400), including a roller axle (62) mounted to a support cup (70) spanning the roller (400) and disposed within the sole cavity, see Column 9, lines 42-44;

wherein the roller (42) contains bearings including rolling elements, see Column 7, lines 30-54;

referring to Figures 15-17, wherein the cup enclosed the roller (900) within the cavity of the sole;

referring to Figure 18, wherein the axle (944), defines a kingpin axis about which the axle (944) rotates and can carry two rollers, see Column 12, lines 37-45 and lines 52-55 and Figure 9;

wherein the axle is disposed between a forward region and an exposed heel region of the sole (14);

wherein the kingpin (950) is defined by a pin disposed for rotation within a socket of the axle mounting structure (946) secured to the sole (14) see Column 12, lines 37-55;

wherein the kingpin axis (950) extends upward.
Therefore, it would have been obvious to one of ordinary skill in the art to modify the state of With regards to claims 40-41 and 49, it would have been obvious to one of Capria w/ the ordinary skill in the art at the time the invention was made to modify the fore-aft distance Adams to between mid-planes of the rollers, to be a specify amount, since it has been held that provide a comfortable, versatile skate assembly.

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where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capria (US 5,249,376) as applied to claim 1 above, and further in view of Chu (US 6,412,791).

Capria teaches all aspects of the claimed invention as discussed above for claim 1, except for a sole defining a cavity wherein a roller is partially disposed within the cavity and extending through the cavity.

Chu discloses a skate (1) having a sole (11) defining a cavity (13) wherein a roller (5) is partially disposed within the cavity (13) and extending through the cavity (13), the skate (1) having a removable roller assembly (5,51), see Figure 6, wherein the roller axle (silent) is mounted to a support cup (51) spanning the roller (5) and disposed with the sole cavity (13) and wherein the support cup (51) is removable from the sole cavity (13) and wherein the support cup (51), roller (5), and axle (silent) are removable from the sole cavity (13) as a unit, and wherein the support cup (51) is selectively positionable in a first position for rolling, in which the roller (5) extends through the cavity (13) opening and a second position for walking in which the roller (5) is fully recessed within the cavity (13), see Figure 5 and 6 and column 2, lines 38-45.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shoe having rollers as taught by Capria with a

removable roller assembly with supporting cup as taught by Chu in order to provide a quick convenient means for removing and reinserting the roller assembly within the shoe.

Claim 36 rejected under 35 U.S.C. 103(a) as being unpatentable over Capria (US 5,249,376) in view of Adams (US 6,450,509) as applied to claim 35 above, and further in view of Kubierschky (US 5,443,277).

Capria as modified by Adams teaches all aspects of the claimed invention as discussed above for claim 35, except, the axle of the sole being secured by a compliant mount.

Kubierschky teaches a rolling shoe or skate having a sole (52), see Figure 2, and including a steerable truck assembly (10,a,10,b) including a pair of rollers (12) mounted to rotate about an axle (46) secured to the sole through a compliant mount that allows tilting of the axle (46) with respect to the sole (52) to vary direction of travel while rolling upon the roller (12), see Abstract;

And a non-steerable centrally disposed roller (not shown) mounted to rotate about a fixed axle spaced from the axle of the steering truck assembly, see Column 1, lines 25-33.

With regards to the non-steerable roller being laterally spaced from the axle of the steerable truck assembly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the non-steerable centrally disposed roller disclosed by Kubierschky to be laterally displaced from the front and rear .

Claims 13-15, 28-33 and 52-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capria (US 5,249,376) as applied to claim 1, and further in view of Roderick et al (US 5,967,552).

Capria teaches all aspects of the claimed invention as discussed above for claim 1, except wherein the roller defines at least two support surface contact points.

Roderick discloses a skate (10) having a roller device (18) having two support surface contact points (80), see Figure 2 or Column 3, lines 15-23, defined on a single roller (18), wherein the rolling member is shaped to engage a flat horizontal supporting surface (20) and disposed in an arch region of the skate, see Figure 1, at one of the contact points (80) in a first roller tilt direction (skate front or nose pointed down) and the other of the contact points (80) in a second roller tilt direction (skate rear or heel down);

wherein the roller (18) comprises a grinding surface (80) that is a circumferential surface of rolling member (18), rigidly secured to the sole of the shoe (10) ;

an alternate embodiment is disclosed wherein the rolling member (44) is shaped to engage a flat horizontal supporting surface at two contact points (44) simultaneously wherein the contact points (44) are defined on at least two independently rotatable rolling members (44), see Figure 6,

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and an alternate embodiment disclosed in Figure 3, wherein there are three rolling members (104) and wherein each roller (104) is a grinding surface, a central roller (104) being a grinding surface disposed between the two outer rollers (104);

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shoes with rollers disclosed by Capria to include a roller or rollers having to points of contact as disclosed by Roderick et al in order to provide the user with increased grinding maneuverability and minimize damage to the shoe of the user from grinding.

With regards to claims 29-33, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the rolling surface span to be a specific amount, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 34 and 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Capria in view of Kubierschky (US 5,443,277).

Capria is discussed above.

Kubierschky teaches a rolling shoe or skate having a sole (52), see Figure 2, and including a steerable truck assembly (10,a,10,b) including a pair of rollers (12) mounted to rotate about an axle (46) secured to the sole through a compliant mount that allows tilting of the axle (46) with respect to the sole (520 to vary direction of travel while rolling upon the roller (12), see Abstract;

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And a non-steerable centrally disposed roller (not shown) mounted to rotate about a fixed axle spaced from the axle of the steering truck assembly, see Column 1, lines 25-33.

With regards to the non-steerable roller being laterally spaced from the axle of the steerable truck assembly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the non-steerable centrally disposed roller disclosed by ^{the combination of Capria and} Kubierschky to be laterally displaced from the front and rear steerable rollers, since it is clear that the rearranging of the parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tifre (US 4,691,453) discloses a shoe having rollers to allow a wearer to roll in any desired direction.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly E Campbell whose telephone number is (703) 605-4264. The examiner can normally be reached on 9:00-5:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson can be reached on (703) 308-0885. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



KEC

May 1, 2003


SEARCHED _____ SERIALIZED _____ INDEXED _____
BRIAN L. JOHNSON 5/2/03
TELEPHONE NUMBER 303-555-3333